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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,177	02/12/2001	Robert Anthony Luciano JR.	GAM-01-002	2454

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Jonathan T. Velasco
c/o Sierra Design Group
300 Sierra Manor Drive
Reno, NV 89511

EXAMINER	
ENATSKY, AARON L	
ART UNIT	**PAPER NUMBER**
3713	8

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/782,177	Applicant(s) LUCIANO ET AL.
	Examiner Aaron L Enatsky	Art Unit 3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-25,27,28,31,32,34-37,52-54,58-68,73 and 75-86* is/are pending in the application.

4a) Of the above claim(s) *52-54, 58-59, and 75-86* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-28,31,32,34-37,60-68 and 73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of amendment on 7/7/03. The arguments set forth in the response are addressed herein below. Rejections based upon this prior art are contained herein below. Furthermore, the prior art rejections of record are being maintained for the reasons set forth in the response to argument section herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-25, 27-28, 31-32, 34-37, 60-68, and 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-37 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between: a countdown indicator, a prize value indicator, a countdown indicator adjuster, and a display for displaying an accumulated prize value. Claim 21 appears to be a disjointed set of elements that are not linked together to enable one of ordinary skill to build the instant invention. Individual elements that Applicant describes are a countdown indicator, a prize value indicator, a countdown indicator adjuster, and a display for displaying an accumulated prize value. Applicant has described that both the countdown indicator and prize

value indicator are visible elements that are manipulated by a game event from a primary event. However Applicant has made no indication of how or what controls the countdown indicator and prize value indicator, if and how they are tied together, and how or what they are visually displayed on. Only the accumulated prize value is properly related to the game machine by reciting visibility on a tangible game machine display versus the unknown display of the countdown indicator and prize value indicator. The clarity also issues also cascade through to the dependent claims. For an example of such clarity problems, take for instance the countdown indicator in claim 31. The countdown indicator is configured to select and indicate another stop position where in said stop position is determined from a random event. The countdown indicator is supposed to be a decrementing indicator, where the art accepted meaning is something that decreases in value, however the countdown indicator is now claimed to be random value selection, not based on any sort of decreasing indicator. Also the claims are not clear as to whether a countdown indicator adjuster is a different mechanism than that which is initially held to alter the countdown indicator.

Claims 60-65 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: 'how a plurality of prize values are generated, if the plurality of prize values are shown, where the plurality of prize values are shown, how is a prize value is "indicated", when and how a plurality of stop adjustments are generated, when and how a particular stop adjustment is "indicated", and whether the stop adjustment is different from the initial countdown indicator or if the stop adjustment just a further explanation of the countdown position. As described above in the 112 rejection of claims 21-37, Applicant appears to have no

clear recitation of how certain game functionality is performed or in this case steps on how to reach some final game outcome.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-25, 27, 31, 34, and 60-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Melen et al. '030 (Hereafter, Melen). Melen teaches a primary game and a countdown game (1:30-48), a countdown indicator with a plurality of stop positions (1:49-52), a prize indicator which allows accumulation of prize values (2:33-44), a prize display and accumulated prize value (Fig. 1 ref. 7), a plurality of winning and non-winning stop positions associated with a countdown indicator (Fig. 1 ref. 4), a countdown indicator having an initial position that gets reset in a non-triggering game event of a predetermined number (1:110-116), the countdown indicator adjusts according to a triggering game event (1:116-124), countdown adjuster and prize indicator activated only at a game triggering event (1:125-2:25), indicating prize values at random events (2:17-25), a countdown adjuster to adjust countdown indicator (Fig. 1, ref. 6), the primary game is adjusted through the adjustment of the counter (1:125-2:11), and the countdown adjustments are made through a random event (1:125-2:11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melen as applied to claims 21-25, 27, 31, 34, and 60-65 above, and further in view of Schneier et al. '398 (Hereafter, Schneier). Melen teaches the claimed limitations as discussed above, but does not teach providing a predetermined result from a finite pool of outcomes. Schneier teaches providing a predetermined result from a finite pool of outcomes so that game device management knows exactly what outcomes were provided (9:35-42). One would be motivated to modify the gaming machine taught by Melen to include the predetermined results taught by Schneier so that gaming management would knows exactly what outcomes were provided to increase security and prevent fraud. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Melen to include the predetermined results taught by Schneier to increase management awareness and game security.

Claims 35-37, 66-68, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melen as applied to claims 21-25, 27-28, 31-32, 34, and 60-65 above, and further in view of Takemoto et al. '034 (Hereafter, Tak). Melen teaches the claimed limitations as discussed above in addition to a countdown indicator adjuster comprising a wheel (Fig. 1, ref 6), but fails to disclose all of the indicators comprising wheels in a concentric format. Tak teaches all game elements indicators comprising concentric wheels (Figures 1-3). The inventions are related in

that both are gambling game machines and both already encompass wheels or a wheel for an indicator where one would be motivated to modify Melen to use all indicators on concentric wheels taught by Tak to allow all figures to be clearly seen to give an game participant a reference for a better game understanding (3:003). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Melen to use the concentric wheels indicators taught by Tak to give a player increase enjoyment through a better understanding of the game being played.

Response to Arguments

Applicant's arguments filed 4/21/03 have been fully considered but they are not persuasive. Applicant has provided arguments regarding how the relationships of the elements in the instant invention differ from Examiner's references use in the Office Action of Paper No. 3. These arguments are held not persuasive due to issues of clarity of Applicant's claimed invention as detailed in the new USC 112 rejections above. The 112 rejections go to the very point of Applicant's arguments of the relationship of elements in the game machines. Examiner holds that Applicant has not clearly defined certain game elements, how they are created, and how they affect the relationships between the game elements. Without such, Applicant's arguments on how the instant invention and the references differ in how the elements relate to each other are not persuasive. Thus, it is also held that Applicant's arguments are not commensurate in scope with that which is currently claimed. Therefore, Applicant's disjointed game elements still read on cited prior art and the prior rejection is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Aaron Enatsky

September 9, 2003

T. Walberg

Teresa Walberg
Supervisory Patent Examiner
Group 3700